

REMARKS

The Examiner is thanked for the thorough review and consideration of the pending application. The Office Action dated October 30, 2008 has been received and its contents have been carefully reviewed.

Summary of the Office Action

Claims 1, 3-6, 8-11, 13-24, 26, 29-48, 50 and 51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,806,072 to Kuba et al. in view of U.S. Patent No. 5706457 to Dwyer et al.

Claims 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. in view of Dwyer et al., and further in view of U.S. Patent No. 6,002,837 to Niida et al.

Claims 12 and 27-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. in view of Dwyer et al. and further in view of U.S. Patent No. 5,815,160 to Kikuchi et al.

Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. in view of Dwyer et al., and further in view of U.S. Patent No. 6,192,191 to Suga et al.

Summary of the Response to the Office Action

Claims 1, 10, 19-21, 26, 28-31, 35, 39, 40 and 43 have been amended to further clarify the invention. Claims 2-9, 11, 13-15, 18, 27, 36-38 and 42 have been cancelled without prejudice or disclaimer. Accordingly, claims 1, 10, 12, 16, 17, 19-26, 28-35, 39-41, 43-48 and 50-51 are pending in the present invention for further consideration.

All Claims Comply with 35 U.S.C. § 103(a)

Claims 1, 3-6, 8-11, 13-24, 26, 29-48, 50 and 51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,806,072 to Kuba et al. in view of U.S. Patent No. 5706457 to Dwyer et al. Claims 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. in view of Dwyer et al., and further in view of U.S. Patent No. 6,002,837 to Niida et al. Claims 12 and 27-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. in view of Dwyer et al. and further in view of U.S. Patent No. 5,815,160 to Kikuchi et al. Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. in view of Dwyer et al., and further in view of U.S. Patent No. 6,192,191 to Suga et al. Applicants traverse the rejection for the following reasons.

With respect to independent claims 1, 10 and 29, as amended, Applicants respectfully submit that Kuba et al. does not disclose the claimed combination including at least the feature of “a recording medium stores a compressed moving image file.” The Office Action asserts that Kuba et al. teaches the claimed limitation in columns 31-32. Applicants respectfully disagree. Kuba et al. only teaches that the image data is stored in the memory card (see column 31, lines 14-28 and column 32, lines 44-67). However, Kuba et al. does not teach or suggest the image data is moving image data as claimed in the present invention. Furthermore, Dwyer et al. does not overcome the deficiencies of Kuba et al. discussed above.

With respect to independent claims 45, 48 and 50, as previously presented, Applicants respectfully submit that the present invention relates to an apparatus and method wherein images are recorded and edited directly on a recording medium through use of a scenario file.

Specifically, independent claim 45 recites a scenario file that includes a reproduction start point and a reproduction end point of the moving image data; independent claims 48 and 50, call for a scenario file that includes at least one of a replaying speed of the image file, a number of repetitions for replaying the image file, a replay range of the image file, a special effect, and a replay of sound associated with the image file, that is stored in the memory.

Applicants respectfully submit that Kuba et al. fails to teach or suggest a scenario file as claimed in the present application. Rather, Kuba et al. relates to an image recorder and file manager of the images recorded. Kuba et al. teaches that once the images are recorded, they can be stored and displayed by date, event, etc. However, Kuba et al. is silent about editing images once they are recorded according to a separately recorded scenario file. Moreover, while the Office Action states that Kuba et al. teaches a scenario file, the Action fails to specifically point out where in Kuba et al. such a scenario file is taught, but rather obtusely cites to columns 31-32 of the patent.

The other cited references, Dwyer et al., Niida et al., Kikuchi et al., and Suga et al., either separately or in combination, fail to overcome the deficiencies of Kuba et al. None of these references teach or suggest a scenario file as claimed in independent claims 45, 48 and 50.

As pointed out in M.P.E.P. § 2143 (A), to establish *prima facie* obviousness of a claimed invention, there must be a finding that the prior art includes each element claimed. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn because Kuba et al. singly, or in combination with the other cited reference, does not teach or suggest each feature of independent claims 1, 10, 29, 45, 48, and 50.

Additionally, Applicants respectfully submit that dependent claims 12, 16, 17, 20-26, 28, 30-35, 39-41, 43,44, 46 and 51 are also allowable insofar as they recite the patentable combinations of features recited in their respective independent claims 1, 10, 29, 45, 48, and 50, as well as reciting additional features that further distinguish over the applied prior art.

Claims 2-9, 11, 13-15, 18, 27, 36-38 and 42 have been cancelled without prejudice or disclaimer, thus rendering the rejections of these claims moot.

CONCLUSION

In view of the foregoing, Applicants respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: Mary Jane Boswell
Mary Jane Boswell
Reg. No. 33,652

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Customer No.: 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Telephone: 202-739-7000

Facsimile: 202-739-3001